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EXAMINER

JONES, SCOTT E

ART UNIT PAPER NUMBER

3713

DATE MAILED: 01/02/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,003

Applicant(s)

BAERLOCHER ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11 . 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. This office action is in response to the request for continued examination and amendment filed on October 20, 2003 in which applicant amends claims 1, 12, 30, 42, 47, 48, and 49, submits a supplemental information disclosure statement, and responds to the claim rejections.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 20, 2003 has been entered.

Specification

3. The disclosure is objected to because of the following informalities:

- On page 28, line 14, "100" should be "145" as shown in figure 6.
- On page 45, line 9, screen "202" is not shown in figure 13 as described.

Correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4-7, 12-25, 30-32, 34-40, 42, and 47-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Rose (U.S. 6,589,114).

Rose discloses a game of chance conducted on a video gaming machine controlled by a processor in response to a wager. The game includes a plurality of symbols randomly selected for placement in a displayed symbol array. A shuffle feature is triggered in response to the displayed symbols including a sequence of value-based symbols. The sequence defines a first award. The sequence of value-based symbols is then re-ordered such that the re-ordered sequence defines a second award. The second award is awarded to the player. Furthermore, the shuffle feature may include a sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction, to define the award given to the player.

Rose additionally discloses:

Regarding Claim 1:

- a display device (12) (Figures 1 and 2);
- a plurality of player selectable positions (60)(62)(64) displayed by the display device (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9); Rose discloses the shuffle feature may include a sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction (such as player selection), to define the award given to the player.
- a processor which communicates with the display device, which enables a player to select the positions, which associates numbers with the positions based on the player's selection of the positions and which determines an award based on an order of the numbers associated with the positions, wherein the award is based on a number of

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monetary units equal to the order of the numbers associated with the positions
(Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9).

Regarding Claims 2 and 15:

- wherein the positions include at least a one's digit and a ten's digit for the award
(Figures 3-7 and Column 4, line 1-Column 5, line 9).

Regarding Claims 4 and 35:

- includes an initial sequence controlled by the processor for determining how many
positions the player is enabled to select (Column 4, line 66-Column 5, line 3).

Regarding Claims 5, 21, 36, and 50:

- the initial sequence includes a plurality of player selectable inputs and a number of
positions associated with each selectable input (Column 4, line 66-Column 5, line 3).

Regarding Claim 6:

- includes a player selectable modify input which communicates with the processor,
wherein activation of the modify input initiates an award modification method
(Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9). The
player can provide an input to initiate the shuffle feature.

Regarding Claims 7, 25, and 40:

- the award modification method is an award rearrangement method (shuffle feature)
(Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9).

Regarding Claim 12:

- a display device (12) (Figures 1 and 2);

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- a plurality of masked numbers (Shamrocks (60),(62), and (64)) displayed by the display device (Figure 3, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9);
- a processor which communicates with the display device and enables a player to arrange at least two of the masked numbers in an order decided by the player (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9); Rose discloses the shuffle feature may include a sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction (such as player selection), to define the award given to the player.
- an award determined by the processor and provided to the player based on the order of the masked numbers arranged by the player, wherein the amount of the award is based on the number of monetary units equal to the order of the masked numbers arranged by the player (Abstract, Column 4, lines 21-25, and Claim 6).

Regarding Claim 13:

- the numbers are digits and the award is a number of credits which is the order of the digits (Abstract, Column 4, lines 21-25, and Claim 6).

Regarding Claim 14:

- includes a plurality of award positions (60)(62)(64) displayed by the display device, wherein the processor enables the player to arrange at least two of the masked numbers in the award positions (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9); Rose discloses the shuffle feature may include a sequence

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of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction (such as player selection), to define the award given to the player..

Regarding Claim 16:

- includes at least three masked numbers and wherein the award positions include at least a one's digit, a ten's digit and a hundred's digit (Figures 3-7 and Column 4, line 1-Column 5, line 9).

Regarding Claim 17:

- includes a set of numbers stored in a memory device (system memory 22) accessed by the processor, wherein the processor randomly generates the masked numbers from the set of numbers in the memory device (Column 4, lines 1-57).

Regarding Claim 18:

- each of the numbers of the set are unique (Column 4, lines 27-34).

Regarding Claim 19:

- at least two of the numbers of the set are the same (Column 4, lines 1-57). Each Award (Credit Amount) is associated with a weighted probability table such as that shown in column 4. For instance, there is some probability that the same number, such as 999, will be selected for two or more of the “biggest” number, “middle” number, or “small” number.

Regarding Claim 20:

- includes an initial sequence controlled by the processor for determining how many masked numbers the player will arrange (Column 4, line 66-Column 5, line 3).

Regarding Claims 22 and 37:

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- includes a plurality of reels controlled by the processor, wherein said masked numbers (Shamrocks (60),(62), and (64)) are randomly generated by at least one of the reels (Figure 3, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9).

Regarding Claims 23 and 38:

- includes a player selectable keep input which communicates with the processor, wherein activation of the keep input by the player causes the processor to transfer the award provided to the player to a credit meter controlled by the processor (Figure 3, Column 4, lines 21-25, and Column 5, lines 1-9). The player initiating the shuffle feature would constitute a player selectable input to keep the award given to the player.

Regarding Claims 24 and 39:

- includes a player selectable modify input which communicates with the processor, wherein activation of the modify input initiates an award modification method (shuffle feature) (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9).

Regarding Claim 30:

- a display device (12) (Figures 1 and 2);
- a plurality of positions (60)(62)(64) (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9);
- a plurality of selections displayed by the display device (60)(62)(64) (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9); and

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- a processor which communicates with the display device, which associates a plurality of numbers with the selections, which enables a player to associate the selections with the positions, which causes the display device to display the numbers associated with the selections that have been ordered in association with the positions, and which determines the award which is the order of the numbers associated with the positions, wherein the amount of the award is based on the number of monetary units equal to the digit order of the numbers associated with the positions (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9); Rose discloses the shuffle feature may include a sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction (such as player selection), to define the award given to the player.

Regarding Claim 31:

- which includes three positions (Figures 3-7 and Column 4, line 1-Column 5, line 9).

Regarding Claim 32:

- the award includes each of the selections displayed by the display device (Figures 3-7, Column 3, line 51-Column 4, line 57, Column 5, lines 1-9, and Claim 6).

Regarding Claim 34:

- wherein the plurality of positions (Shamrocks (60),(62), and (64)) are displayed by the display device before the player associates the selections with the positions (Figure 3).

Regarding Claim 42:

- a display device (12) (Figures 1 and 2);

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- a processor which communicates with the display device (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9);
- a plurality of selections displayed by the display device (Shamrocks (60),(62), and (64)) (Figure 3); and
- a selection orderer (shuffle feature) which communicates with the processor and enables the player to select and order at least two selections with digits to form an award, wherein the processor reveals the award by displaying a number associated with each selection in the digit selected by the player, and wherein the award is based on a number of monetary units equal to the order of the numbers associated with the selections. (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9). Rose discloses the shuffle feature may include a sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction (such as player selection), to define the award given to the player.

Regarding Claim 47:

- a display device (12) (Figures 1 and 2);
- a plurality of selections displayed by the display device (Shamrocks (60),(62), and (64)) (Figure 3); and
- a processor which communicates with the display device, which associates numbers with selections, and which enables a player to associate selections with a one's digit and a ten's digit of an award provided to the player, wherein the award is based on a number of monetary units equal to the order of the numbers associated with the one's and ten's digit (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5,

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lines 1-9). Rose discloses the shuffle feature may include a sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction (such as player selection), to define the award given to the player.

Regarding Claim 48:

- a display device (12) (Figures 1 and 2);
- a plurality of selections (Shamrocks (60),(62), and (64)) displayed by the display device (Figure 3); and
- a processor which communicates with the display device, which associates numbers with selections, and which enables a player to associate selections with a one's digit, a ten's digit and a hundred's digit of an award provided to the player, wherein the award is based on a number of monetary units equal to the order of the numbers associated with the one's digit, ten's digit, and hundred's digit (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9). Rose discloses the shuffle feature may include a sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction (such as player selection), to define the award given to the player.

Regarding Claim 49:

- an initial determination of a number of possible digits for a player's award (Column 5, lines 1-9);
- a display device (Figures 1 and 2);
- a plurality of selections (Shamrocks (60),(62), and (64)) displayed by the display device (Figure 3); and

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- a processor which communicates with the display device, which associates numbers with selections, and which enables the player to associate selections with the number of possible digits provided by the initial determination to form an award provided to the player wherein the award is based on a number of monetary units equal to the order of the digits (Figures 3-7, Column 3, line 51-Column 4, line 57, and Column 5, lines 1-9). Rose discloses the shuffle feature may include a sequence of value-based symbols that are randomly re-ordered/shuffled, with or without player interaction (such as player selection), to define the award given to the player.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 33, 43-46, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. 6,589,114).

Rose discloses to one having ordinary skill in the art that as discussed above regarding 1-2, 4-7, 12-25, 30-32, 34-40, 42, and 47-50. However, Rose seems to lack explicitly disclosing:

Regarding Claim 33:

- wherein the award includes a different number of selections than the plurality of selections displayed by the display device.

Regarding Claim 43:

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- wherein the selection orderer is adapted to enable the player to rearrange an ordering of the selections a plurality of times before pressing a keep button displayed by the display device.

Regarding Claim 44:

- wherein the selection orderer includes a prompt to place a selection in a designated position.

Regarding Claim 45:

- wherein the selection orderer enables the player to press and drag a selection to a position.

Regarding Claim 46:

- wherein the selection orderer remembers a selection chosen by the player and places the selection in a position subsequently chosen by the player.

However, Rose teaches, the present invention has been described with reference to one or more particular embodiments, those skilled in the art will recognize that many changes may be made thereto without departing from the spirit and scope of the present invention. For example, the sequence of value-based symbols for triggering the shuffle feature need not be in linear or horizontal alignment as illustrated in FIGS. 3 through 7, but rather may be in predefined vertical alignment or even a predefined non-linear or scatter arrangement. Also, the number of shuffled value-based symbols employed in the shuffle feature may be less than or greater than three so long as the ultimate credit amount awarded to the player allows the gaming machine to remain profitable. Further, the shuffle feature may be implemented as a "second-screen" feature in which the reels disappear and a new scene is presented to the player for a bonus round. The

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scene would include a sequence of value-based symbols that are randomly re-ordered, with or without player interaction, to define an award given to the player. Each of these embodiments and obvious variations thereof is contemplated as falling within the spirit and scope of the claimed invention, which is set forth in the following claims.

Therefore, to one having ordinary skill in the art at the time of applicant's invention, these features were either notoriously well-known in computer based application software or could easily have been implemented in the computer program(s) running the gaming machine. Since electronic slot machines have been implemented on gaming devices having microprocessors, one would be motivated to use these notoriously well known computer based applications for a player to select and position a player selectable winning combination on a display device (12) as shown in Figure 1 in order for a player to obtain an award and such that the application allows the gaming machine to remain profitable for a casino operator.

8. Claims 3 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (U.S. 6,589,114) as applied to claims 1-2, 4-7, 12-25, 30-32, 34-40, 42, and 47-50 above, and further in view of Hamano (U.S. 5,205,555).

Rose seems to lack explicitly disclosing:

Regarding Claims 3 and 29:

- the award is based on the order of at least three positions, wherein the numbers associated with two of said positions/masked numbers are combined by a mathematical operation.

Hamano teaches of a gaming machine that determines an award for a player by performing a mathematical computation of the numbers that stop on the top line of reels of a

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gaming machine (Claims 3 and 29). Hamano is analogous art because, like Rose, is an electronic gaming device.

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Hamano's process for determining and calculating a player award in a gaming machine in Rose. Doing so, one would be motivated to incorporate Hamano's process for determining and calculating a player award in Rose to provide an electronic game that is complicated and more interesting than simply relying on an award paid in response to a predetermined or player determined combination that is in a one to one, fixed relationship with a predetermined stored pay table in the gaming machine.

Double Patenting

9. Claims 1-50 of this application conflict with claims 1, 6-9, 13-15, 16, 20-25, and 28 of Application No. 09/933843. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6-9, 13-15, 16, 20-25, and 28 of copending Application No. 09/933843. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims a gaming device comprising: a display device; an original award having a plurality of digits displayed by the display device; and a processor which communicates with the display device, which causes the display device to display said rearranged award and which provides the rearranged award to a player. The only difference being the way the award is selected (rearranged). However, a random player selection and a processor random rearrangement are obvious over each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Response to Arguments

11. Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Seibert, Jr. et al. '234 discloses a player activated matching jackpot device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Scott E. Jones
Examiner
Art Unit 3713



SEJ
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